

REMARKS

Claims 1-5, 7-9, 11-13, 15-17 and 19-23 are pending and stand ready for further action on the merits. Claims 6, 10, 14, and 18 have been cancelled, without prejudice.

Claim 22 has been amended to be of the same scope as claim 1. It is respectfully submitted that there is sufficient support in the specification for claim 1, as currently amended, and also claim 22. This matter will be discussed below in detail.

No new matter has been added by way of the above-amendment.

Interview

Applicants note with appreciation that the Examiner conducted a telephonic Interview with Applicants' representative, Garth M. Dahlen, Ph.D., Esq. (#43,575) on February 24, 2006 to discuss the issues. The Examiner and Dr. Dahlen discussed where the specification provides support for the phrases described as being new matter in the outstanding Office Action. The Examiner was not in a position to allow the case based upon the telephone conversation and requested that Applicants file this paper. Further details of the discussion are provided below.

The following sections correspond to the sections of the outstanding Office Action.

Section "2"

In the paragraph numbered as "2", the Examiner has indicated that new claim 22 is directed to an invention that is distinct from the category of invention as originally filed. Specifically, the Examiner objects to the fact that new claim 22 is drawn to a method, whereas all previously filed claims are drawn to a product. The Examiner has withdrawn claim 22 from consideration as being drawn to non-elected subject matter.

The Examiner will note that Applicants have amended claim 22 to be of the same scope as claim 1. Accordingly, the Examiner will be required to rejoin claim 22 with product claims 1-5, 7-9, 11-13, 15-17, 19-20 and 23, once these product claims have been found to be allowable as set forth in MPEP §806.5(f).

Issues under 35 U.S.C. § 112, First Paragraph

Claims 1-5, 7-9, 11-13, 15-17, 19-21 and 23 are rejected under 35 U.S.C. § 112, first paragraph for containing new matter. The Examiner objects to several numerical ranges in claim 1 as being new matter. Applicants respectfully traverse the rejection.

The Examiner objects to the phrase, "10 - 50 mol% of diphenylsiloxane units". In response, Applicants respectfully bring to the Examiner's attention that there is support for this range by combining two ranges. The first range is 5 - 50 mol% as found on page 3, line 13. The second range is 10 - 30 mol% as found on page 3, line 14. Accordingly, both end points of 10¹ and 50 are described in the specification. As such, the phrase "10 - 50 mol% of diphenylsiloxane units" does not constitute new matter.

The Examiner objects to the range of "20 to 50 mol% of methylphenylsiloxane units" in claim 1. In response, Applicants respectfully bring to the Examiner's attention that support for this range can be found in two ranges in the specification. At page 3, line 16, there is the range of 10 - 50 mol%. Also, at page 3, line 17, is the range of 20 - 40 mol%. Since both the end points of 20² and 50 mol% can be found in the present specification, the range of "20 to 50 mol% of methylphenylsiloxane units" in claim 1 does not constitute new matter.

A case which supports Applicants' position is *Kolmes v. World Fiber Corp.* 41 U.S.P.Q.2d 1829 (Fed. Cir. 1997). The patent concerned a cut-resistant yarn for use in making products such as gloves. Unlike the prior art, the yarn did not use metallic components such as wire. The yarn included two core strands wrapped in opposite directions around two covering strands. One core strand was of fiberglass; the other core strand and the covering strands were of nylon or other materials. The patent's claim, added by a preliminary amendment filed with the continuation-in-part application, required, inter alia, that there be a two strand core and that the covering strands be "wrapped about said core at the rate of 8-12 turns per inch." The accused infringer argued that the limitations referring to a two-strand core and 8-12 turns per inch were

¹ The value of "10 mol% diphenylsiloxane" also has support at page 5, lines 32-33 and page 17, lines 32-36.

² The value of "20 mol% methylphenylsiloxane" also has support at page 12, lines 18-20.

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“new matter” added in the 1992 continuation-in-part application and, therefore, that the patent’s claims were not entitled to the benefit of a 1990 parent application. The Federal Circuit disagreed.

“[The specification] states that the coverings or wrappings are formed ‘at the rate of 4-12 turns per inch, with 8 turns per inch being preferred.’ All the claimed limitation including the 8-12 turns per inch are thus well supported by the specification.” Id. at 1832.

In other words, it was not “new matter” to recite a range in a claim **using endpoints from two different ranges** as was done with the range, “10 - 50 mol% of diphenylsiloxane units” and the range of “20 to 50 mol% of methylphenylsiloxane units in instant claim 1.

Lastly, the Examiner objects to the range “a contact angle of up to 55°” as found in claims 1 and 23. In response, Applicants respectfully bring to the Examiner’s attention that there is a range of “up to 70°” at page 2, lines 17-18. The new end point of 55° can be found in Table 1 in Example 5, and Table 2 in Example 11. Since the specification specifically recites this end point of 55° in an **example**, there is no new matter added to the disclosure by way of this new range of “up to 55°”. Also, as a side note, the standard of “JIS R3257” for measuring the contact angle as recited in the last line of claim 1 has support at page 16, line 31 of the specification.

A case which supports Applicants' position is *In re Blaser*, 194 USPQ 122 (CCPA 1977). At issue in *Blaser*, was whether the phrase “said share of said water in said mixture is from 1.2 to 1.6 mols” had support in a parent case U.S. Serial No. 159,159. If this range did not have support, it would be new matter to the present application and claim 12 would not have the benefit of priority back to the filing date of the parent case. The court noted that in the parent application, there was a range with an upper limit of 1.6 mols which was expressly disclosed and **examples** 1-6 therein ranged from 1.2 to 1.5 mols. The court found that, “[a]s a factual matter, persons skilled in the art would consider processes employing 1.2 to 1.6 mols water as part of appellants' invention and would have been led by U.S. Serial No. 159,159 so to conclude.”

In other words, it was not "new matter" to recite a concentration range using a concentration value found in one of the **exemplified embodiments** as an endpoint in the claimed range as was done with the range, "up to 55°" in instant claim 1.

In the present case, the Examiner has done nothing more than to argue lack of literal support, which is not enough. *In re Lukach*, 169 USPQ at 796, (CCPA 1971), holds that for a proper rejection based on new matter, the Examiner not only has the burden of showing that the claimed invention is not literally described in the specification, but also the Examiner has the burden to give reasons why there is not implicit written description support.

Accordingly, there is sufficient ***implicit*** support for the range, "10 - 50 mol% of diphenylsiloxane units" and the range of "20 to 50 mol% of methylphenylsiloxane units" and the range "a contact angle of up to 55°" in the claims.

As such, withdrawal of the rejection of record – and passage of the present application to Issue – is respectfully requested.

Should there be any outstanding issues to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. (Reg. No. 43,575) at (703) 205-8030.

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Respectfully submitted,

By

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